

REMARKS

In response to the Office Action dated August 5, 2011, Applicants respectfully request reconsideration. Claims 1-12, 14-32, 34-54, 56-71, 73-88, 90-108, and 110-116 were previously pending in this application. By this amendment, Applicants are canceling no claims and adding no new claims. Claims 1, 6, 21, 24, 26, 41, 53, 63, 67, 80, 84, 97 and 104 are herein amended. As a result, claims 1-12, 14-32, 34-54, 56-71, 73-88, 90-108, and 110-116 remain pending for examination, with claims 1, 21, 41, 63, 80 and 97 being independent. No new matter has been added. In view of the following remarks, Applicants believe the pending application is in condition for allowance.

Claim Amendments

Claims 1, 21, 41, 63, 80 and 97 are amended. Support for the Amendments may be found at page 8, including at lines 25-27. During the interview of July 28, 2011, Supervisory Examiner Lee suggested this clarification. Applicants respectfully assert that these amendments are unnecessary; however to advance prosecution Applicants have adopted the Examiner's suggestion. It was agreed that, for the purposes of a further search, the claims would be interpreted as if these amendments had been made. Therefore, Applicants respectfully request the amendments be entered.

Rejections Under 35 U.S.C. §103

Claims 1-12, 14-32, 34-54, 56-67, 69-71, 73-84, 86-88, 90-104, 106-109, and 110-116 stand rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over U.S. Patent No. 6,173,374 (Heil) in view of U.S. Patent Application Publication No. 2005/0097260 (McGovern). These rejections are respectfully traversed. In general, Applicants respectfully assert that the rejection is based on the Office Action mischaracterizing a cluster to be equivalent to the recited claim feature of "clusters."

I. The Office Action Fails to Make a Prima Facie Case of Obviousness for Independent Claim 1

The rejection of independent claim 1 should be withdrawn because the Office Action fails to make a *prima facie* case of obviousness. The Office Action (page 4) asserts that combining elements of McGovern with elements of Heil using known methods would predictably result in the invention of claim 1. As a preliminary matter, if the Office Action is asserting a position that there were known methods of combining elements of McGovern and Heil, Applicants respectfully request that the Examiner place on the record a reference demonstrating that such methods were known.

Moreover, to establish a *prima facie* case of obviousness using this rationale, the Office Action must articulate the following:

(1) a finding that the *prior art included each element claimed*, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference; [and]

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, *each element merely performs the same function* as it does separately. MPEP § 2143(A) (emphasis added).

Applicants respectfully assert that the Office Action has not satisfied both of these prongs.

A. The Office Action Fails to Show That the References Include Each Element Claimed

Independent claim 1 recites, *inter alia*, “determining on which one of the *plurality of storage clusters* the unit of data is stored” (emphasis added). The Office Action (page 4) asserts that this limitation is taught by Heil, citing Fig. 3, step 410. Applicants respectfully disagree.

Heil is generally related to a system that “retrieves data across independent computer nodes of a server cluster.” Abstract. Here, Heil discusses retrieving data within a single server cluster. Further, cited step 410 of Fig. 3 of Heil is directed to determining, within a single cluster, whether the data is stored on a local node or a remote node of the cluster. Col. 11, lines 45-65. However, “retrieves data . . . of a server cluster” is not equivalent to and does not disclose the cited claim feature of “determining on which one of the *plurality of storage clusters*.” Therefore, Heil fails to

teach or suggest “determining on which one of the *plurality of storage clusters* the unit of data is stored” as recited in the claims.

McGovern does not teach or disclose the aforementioned claim feature as McGovern is also directed to the operations within a single computer cluster (§16). Therefore, McGovern does not cure the aforementioned deficiencies. Accordingly, neither Heil nor McGovern, alone or in combination, disclose every limitation of independent claim 1 and there is no prima facie case of obviousness for independent claim 1.

B. The Office Action Fails to Show That Each Element Performs the Same Function

To establish *prima facie* case of obviousness, each element selected from Heil and McGovern must merely perform the same function in the combination as it did in the reference on its own. Independent claim 1 recites, *inter alia*, “determining on which one of the plurality of storage clusters the unit of data is stored ***based on the content address of the unit of data***” (emphasis added). The Office Action asserts that McGovern teaches: “based on the content address of the unit of data.” The Office Action asserts that the element of McGovern meeting this limitation performs the same function in the asserted combination as it does in McGovern, separately. Applicants respectfully disagree.

McGovern (§§16-19) discusses a content address based on the content of a file within a cluster of computers. The only function for which the content address is used is as a unique key by which the file is accessed (*Id.*). There is no teaching, however, of a content address being used in a system comprising a plurality of storage clusters with the ability to identify on “which one of the plurality of storage clusters the unit of data is stored.” If the content address of McGovern merely performs the same function in the purported combination of Heil and McGovern as it does within McGovern alone, the combination would not operate in the manner the Office Action asserts. To determine “which one of the plurality of storage clusters the unit of data is stored,” the content address of McGovern would have to function in a different way than discussed in McGovern.

Therefore, the content address of McGovern cannot be performing the same function as it does within the context of McGovern alone. Accordingly, there is no prima facie case of obviousness for claim 1.

C. The Rejection of Independent Claim 1 Should Be Withdrawn

For at least the aforementioned reasons, there is no prima facie case of obviousness for claim 1. Accordingly, withdrawal of the rejection of independent claim 1 is respectfully requested.

Claims 2-12 and 14-20 depend from claim 1 and are allowable for at least the same reasons.

II. The Office Action Fails to Make a Prima Facie Case of Obviousness for Independent Claim 21

For reasons that should be clear from the above discussion of the references in connection with independent claim 1, there is no prima facie case of obviousness for independent claim 21. For example, claim 21 recites, *inter alia*, “determining on which one of the plurality of storage clusters the unit of data is stored based on the content address of the unit of data.” These limitations are not taught or suggested by Heil and McGovern, alone or in combination. Accordingly, withdrawal of the rejection of independent claim 21 is respectfully requested.

Claims 22-32 and 34-40 depend from claim 21 and are allowable for at least the same reasons.

III. The Office Action Fails to Make a Prima Facie Case of Obviousness for Independent Claim 41

For reasons that should be clear from the above discussion of the references in connection with independent claim 1, there is no prima facie case of obviousness for independent claim 21. For example, claim 41 recites, *inter alia*, “determines on which of the plurality of storage clusters the unit of data is stored based on the content address of the unit of data.” These limitations are not taught or suggested by Heil and McGovern, alone or in combination. Accordingly, withdrawal of the rejection of independent claim 41 is respectfully requested.

Claims 42-62 depend from claim 41 and are allowable for at least the same reasons.

IV. The Office Action Fails to Make a Prima Facie Case of Obviousness for Independent Claim 63

For reasons that should be clear from the above discussion of the references in connection with independent claim 1, there is no prima facie case of obviousness for independent claim 21. For example, claim 63 recites, *inter alia*, “selecting, based on a content address of the unit of data that is based, at least in part, upon at least a portion of the content of the unit of data, one of the plurality of storage clusters to store the unit of data.” These limitations are not taught or suggested by Heil and McGovern, alone or in combination. Accordingly, withdrawal of the rejection of independent claim 63 is respectfully requested.

Claims 64-71 and 73-79 depend from claim 63 and are allowable for at least the same reasons.

V. The Office Action Fails to Make a Prima Facie Case of Obviousness for Independent Claim 80

For reasons that should be clear from the above discussion of the references in connection with independent claim 1, there is no prima facie case of obviousness for independent claim 21. For example, claim 80 recites, *inter alia*, “selecting, based on the content address of the unit of data, one of the plurality of storage clusters as to store the unit of data.” These limitations are not taught or suggested by Heil and McGovern, alone or in combination. Accordingly, withdrawal of the rejection of independent claim 80 is respectfully requested.

Claims 81-88 and 90-96 depend from claim 80 and are allowable for at least the same reasons.

VI. The Office Action Fails to Make a Prima Facie Case of Obviousness for Independent Claim 97

For reasons that should be clear from the above discussion of the references in connection with independent claim 1, there is no prima facie case of obviousness for independent claim 21. For example, claim 97 recites, *inter alia*, “selects, based on the content address of the unit of data, one of the plurality of storage clusters to store the unit of data.” These limitations are not taught or

suggested by Heil and McGovern, alone or in combination. Accordingly, withdrawal of the rejection of independent claim 97 is respectfully requested.

Claims 98-108 and 110-116 depend from claim 97 and are allowable for at least the same reasons.

General Comments on Dependent Claims

Each of the dependent claims depends from a base claim that is believed to be in condition for allowance, and Applicants believe that it is unnecessary at this time to argue the allowability of each of the dependent claims individually. Applicants do not, however, necessarily concur with the interpretation of the dependent claims as set forth in the Office Action, nor do Applicants concur that the basis for the rejection of any of the dependent claims is proper. Therefore, Applicants reserve the right to specifically address the patentability of the dependent claims in the future, if deemed necessary.

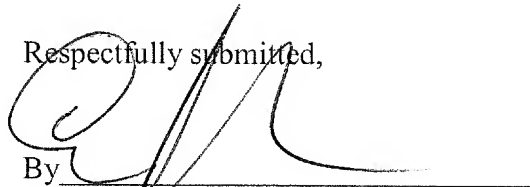
CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, the Director is hereby authorized to charge any deficiency or credit any overpayment in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 23/2825, under Docket No. E0295.70199US00 from which the undersigned is authorized to draw.

Dated: October 5, 2011

Respectfully submitted,



By

Edmund C. Walsh

Registration No.: 32,950

WOLF, GREENFIELD & SACKS, P.C.

600 Atlantic Avenue

Boston, Massachusetts 02210-2206

617.646.8000